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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/661,159

Confirmation No.: 6784

Applicant(s): Vargas

Filing Date: 12 September 2003

Title: "Shape-Transferring Cannula System  
and Method of Use"

TC/Art Unit: 3736

Examiner: Hoekstra, J.

Docket No.: ENDOV-001/US

**Petition**

Date: 23 March 2010

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450



Sir:

Applicant respectfully petitions to withdraw a holding of abandonment, because

Applicant failed to receive a Notice of Non-Compliant Amendment.

I.

The United States Patent and Trademark Office (the "Office") allegedly mailed a Notice of Non-Compliant Amendment (the "Notice") for this application on 17 November 2009. It appears that this Notice was mailed in response to Applicant's amendment document filed on 7 October 2009. As the Notice appears in the Patent Information and Retrieval System, the

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Notice states that the amendment document was non-compliant because the claim status identifier "Amended" should instead be "Currently Amended".

## II.

In accordance with the information outlined in the Manual of Patent Examining Procedure (8th Ed. Rev. Jul. 2008), § 711.03(c), Applicant provides the following statements and information.

A. The system used to record Office actions at Intuitive Surgical, Inc. begins with the receipt of all mail addressed to the correspondence address of record associated with this application being delivered to a central mail room. There, the mail is sorted by recipient address within the company. Mail from the Office is placed in a mail receptacle for the legal department. At least once each day, a clerk in the legal department retrieves the mail from this receptacle. Mail from the Office is first opened and examined by employee Anne Killingsworth, who functions as the legal department's docketing clerk. If a paper from the Office indicates that a response is required by a particular deadline, Anne does two things. First, she retrieves the paper file associated with the particular application and clips the paper to the outside of the file. Second, she enters the due date in the legal department's computerized docketing system record associated with the particular application. For situations that require a response be filed within one month of the paper's mailing date, Anne's general practice is to call one of the legal department's patent attorney's immediate attention to the paper. Anne prepares action due lists for all deadlines entered into the legal department's computerized docketing system, and she provides these lists to the appropriate legal department attorney.

B. The legal department uses the computerized Dennemeyer Intellectual Asset Management System (DIAMS) version 8.04.09.4, provided by Dennemeyer & Co., to record due

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dates associated with papers received from the Office. This is a reliable system. Entry data for each patent application includes the Office's application number, the corresponding attorney docket number, and the due date for any response required by a paper received from the Office.

C. To the best of the undersigned attorney's information and belief, the Notice was not received at Intuitive Surgical, Inc. The undersigned attorney has searched the legal department mail receptacle in the mail room and the surrounding area (e.g., under the receptacle shelves in case the Notice had somehow fallen), the shelf area in which the paper record associated with this application is kept, and the contents the paper record associated with this application but was unable to find the Notice.

D. To the best of the undersigned attorney's information and belief, the legal department first learned that the Notice had been mailed when the legal department received a Notice of Abandonment that the Office appears to have mailed on 19 February 2010. Upon receipt of this Notice of Abandonment, Anne Killingsworth accessed the Office's Patent Application Information Retrieval system and was able to download a copy of the Notice of Non-Compliant Amendment.

E. To the best of the undersigned attorney's information and belief, the docketing system does not provide a "master docket for the firm" for a particular date range in any usable form. In lieu of such a "master docket", attached to this Petition as Exhibit 1 are (i) an image of the portion of the docketing system record that is associated with this application's identifying details, and (ii) two images that show the portion of the docketing system record that is associated with this application's due dates (completed and pending). These images indicate that the due date associated with the Notice was not entered into the legal department's docketing system, and they are submitted as further evidence that the Notice was not received. The images

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show that some portion of the record associated with this application was updated on 24 November 2009, but again, there is no evidence that any due date associated with the Notice was entered. After discussing this matter with Anne Killingsworth, the undersigned attorney was unable to determine what portion, if any, of this record was updated on 24 November 2009.

III.

Applicant respectfully petitions the Director under 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment. Accordingly, Applicant believes that no petition fee is due.

If, however, the Office determines that this Petition is more correctly made under 37 C.F.R. § 1.137(a) or 1.137(b), then to speed handling of this Petition the Office is authorized to deduct from Deposit Account No. 503404 \$540.00 (for § 1.137(a)) or \$1620.00 (for § 1.137(b)) as may be necessary.

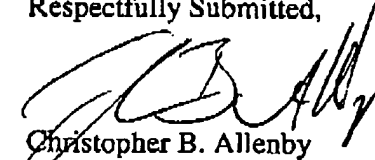
In addition, the Office is authorized to deduct from Deposit Account No. 503404 any additional fees that may be due to reopen prosecution of this application. Large entity fees apply.

IV.

Applicant includes with this Petition a corrected version of the amendment paper filed 7 October 2009. This corrected version includes the correct claim status identifiers for all claims.

Applicant respectfully requests the Director grant this petition. Please contact the undersigned attorney at 408-523-2460 if there are any questions.

Respectfully Submitted,



Christopher B. Allenby  
Registration No. 45,906

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## Exhibit 1

## Docket System Images

This is the "Patent Details" page from the assignee's DIAMS record that is associated with this application:

DIAMS Patent Management (View only)

File Main Menu Reports Utilities Research Windows Help

Book ID: ENDOV001/US Short Title: CANNULA SYSTEM & METHOD OF USE

Client/Business Unit:  Applicant/Patentees:  Other Party: ☐

Related Matters: ☐ Inventors: ALLENBY CHRISTOPHER

Cost Centers:  Laboratories:

Inventors: VARGAS JAIME S

Invention | Disclosure | Disclosure 2 | Prior Art | Names | Patent Details | Additional Info | Docs link | Docketing

Country:  Convention:  Type:  Application No: 10/661159 Application Date: 12-Sep-2003

Region:  Origin:  Sub Type:  Grant No:  Grant Date:

Status:  Independent Claims:  Request Search Date:  1st Publication No: 2004-0054322 1st Publication Date: 18-Mar-2004

Sub Status:  Dep. Multi-Dep. Request Exam Date:  2nd Publication No:  2nd Publication Date:

Published:

Claimed Priorities & Parent Records

Priority: ENDOV001PROV/US 12-Sep-2002

File Status:  Abandoned Date: 06-Aug-2007 Expiration Date: 12-Sep-2023

File Ref:  Last Annulity Paid:  Next Annulity Due:

Annulity Instructions:  Calculate Expiration & Annulity Fees/Dates

Record: 2/5 Created 15-Nov-2007 ANNEK Updated 24-Nov-2009 ANNEK 22-Mar-2010

Ready

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This is the first of two images that show docket entries (due and completed) currently in the DIAMS system that are associated with this application. Note that the current assignee purchased this application after it had been filed and prosecution begun, and so not all docket entries associated with the full history of this application are shown. Note also that although this record was last updated on 24 November 2009 (the update information appears near the bottom of the image), no docket entry appears for the Notice of Noncompliant Amendment.

DIAMS - Patent Management (View only)

File Edit Menu Reports Utilities Research Windows Help

Docket ID: ENDOVD01/US Short Title: CANNULA SYSTEM & METHOD OF USE Client/Inventor Units: Applicant/Patentee: Other Party: ☐

Attorneys: ALLENBY CHRISTOPHER Cost Center: Inventors: VARGAS JAIME S Laboratories:

Related Matters:

Invention Disclosure Disclosure 2 Prior Art Names Patent Details Additional Info Docs Link Docketing

Phase: ☒ NYF ☐ Pending ☐ Grant ☐ All ☒ Events ☒ To Do ☒ Done Subphase: 1 of 1 From: To:

Action/Event	Inventor/Inventor	Date	From	To
Application Date	10/661159	12-Sep-2003		15-Nov-2007
Publ: First	2804-005432	18-Mar-2004		20-Oct-2008
OA1 Mail Date		17-Feb-2006		15-Nov-2007
Final OA Mail Date		01-Nov-2006		15-Nov-2007
ADVISOR OPINION		21-Feb-2007		15-Nov-2007
Abandoned Date		06-Aug-2007		15-Nov-2007
Restoration Requirement Mail Date		29-Oct-2008		04-Nov-2008
IDS VERT & ATTY		12-Nov-2008		17-Nov-2008
IDS entry		12-Dec-2008		17-Dec-2008
est		29-Dec-2008		05-Dec-2008
OA2 Mail Date		07-Apr-2009		09-Apr-2009
Expiration Date		12-Sep-2023		15-Nov-2007
OA1 Response Date		17-May-2006 13-Aug-2006	42491	15-Nov-2007
Final Response 2 Mo Rem		01-Dec-2006		15-Nov-2007

Record 1/25 Created: 15-Nov-2007 ANNEK Updated: 24-Nov-2009 ANNEK 22-Mar-2010

Ready NUM

This is the second of two pages that show docket entries (due and completed) currently in the DIAMS system that are associated with this application.

\*\*\*\*\* Last Item \*\*\*\*\*